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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Application Number 10/705,657 Filed November 10, 2003 Inventor Jeremy Thaler Art Unit 1761 Examiner H. Pratt Confirmation 6140 Docket Number 1077 001 301 0202
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.
Registration number 34,545.

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____.

Signature 

Typed or Printed Name Duane C. Basch

Telephone Number 585-899-3970

Date June 18, 2008

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required.

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE REQUEST

Status

The Office Action Summary correctly acknowledges that claims 1, 3-20 and 22-24 remain pending in the application. The rejection under 35 USC §112, second paragraph, has been withdrawn and the remaining rejections are all under 35 USC §103(a). Claims 1, 10, 12-18 and 20 and 22-23 were rejected under 35 USC §103(a) as being unpatentable over Liu (Liu et al.; 6,982,101) in view of Hinds (Journ. Food Sci.) and Harris (Harris et al.; 2,560,509). Claims 1, 3-8, 10, 12-18, 20 and 22-23 were rejected under 35 USC §103(a) as being unpatentable over Hinds. Claims 9, 11, 19 and 24 were rejected under 35 USC §103(a) as being unpatentable over _____ and further in view of Krisinski (Krisinski et al.; 4,143,176).¹

Requirements for Obviousness Rejection

As MPEP §2141 states, the Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. ... '[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *KSR Int'l v. Teleflex, Inc.*, 82 USPQ2d at 1396, quoting *In re Kahn*, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). As set forth below, the rejections are not explicit, and in most cases fail to provide the articulated reasoning necessary to establish *prima facie* obviousness.

Applicants also refer to MPEP 2143.03, which states that "[t]o establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. Citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)."

Claims 1, 10, 12-18 and 20 and 22-23 were rejected under 35 USC §103(a) as being unpatentable over Liu in view of Hinds and Harris.

¹ Applicants respectfully note that the rejection of claims 9, 11, 19 and 24 is incomplete as it fails to indicate whether Krisinski is to be combined with Hinds alone or with the combination of Liu, Hinds and Harris.

Applicants respectfully submit that the rejection fails to expressly set forth a basis for the alleged combination/modification of Liu, Hinds and Harris. Absent any articulated reasoning as the basis for the combination/modification, the combination is urged as improper and that *prima facie* obviousness has not been established.

Considering the combination, *in arguendo*, Applicants respectfully maintain that Liu clearly teaches away from the present invention as it is directed to nut butter spreads and, as the Examiner indicates, does not teach "at least about 90wt% organically grown, dry-roasted, ground peanuts." While describing steps for making spreads, Liu specifically states that peanut oil is the preferred edible oil for peanut butter (col. 3, lines 9-10), and clearly suggests that a "sweetening composition" be added to nut pastes (col. 3, lines 35-36). The sweetening composition preferably includes a stabilizer to prevent oil separation between the solid and edible oil phases (col. 3, lines 65-67).² The stabilizers are described by Liu as "hydrogenated vegetable oils and their derivatives" (col. 4, line 1).

Applicants respectfully urge that the teaching in Liu is contrary to the present invention which is intended to provide an organic, non-hydrogenated peanut butter, not a spread that includes peanut oil and hydrogenated stabilizers, and thereby teaches away from the present invention and those additional references urged as the basis for the rejection. Applicants further urge that the Examiner has mischaracterized Liu's teaching of "at least one stabilizer" in a total amount up to 3 - 4wt% (see e.g., col. 2, lines 3-25) as no stabilizer being present, whereas Liu clearly teaches the use of hydrogenated stabilizers. The Examiner's reference to the method set out at the bottom of col. 1, while not expressly teaching the addition of a stabilizer as a step, does teach addition of a "sweetening composition" - which is characterized at col. 3, line 65 as "preferably also includes a stabilizer to prevent separation ..." In the alternative, Liu may be considered indicia that Applicants' organic peanut butter, achieved using a non-hydrogenated organic oil to prevent separation, was contrary to the accepted wisdom of those skilled in the art. Thus, not only does Liu fail to teach the recited claim limitations, but it teaches away from the claimed invention by indicating a preference for the use of hydrogenated vegetable oil stabilizers and their derivatives (col. 4, line 1).

² The Examiner urges, at p. 10 of the Final Office Action, that claims 10-14 and 50-52 of Liu do not require a stabilizer. Applicants respectfully urge that this is an erroneous interpretation and ignores the clear teaching of a sweetening composition by Liu (col. 3, lines 65-67), and the recitation of the sweetening composition in the independent claims from which claims 10-14 and 50-52 depend.

Liu also fails to teach about 5wt% to about 7wt% of a non-hydrogenated organic palm stearin oil as is now set forth in the rejected independent claims. The Examiner urges that this limitation is taught by Liu's suggestion of the use of palm oil, but Applicants maintain that even if palm oil is taught, the specific type and amount of the oil required to achieve the results set forth (e.g., an organic peanut butter that has a fat concentration below 55wt% and is resistant to separation) are not disclosed by Liu.³ The rejection fails to set forth where the disclosure of the recited limitations is found. Absent a teaching or demonstration that all of the recited limitations were available to one of skill in the art, the rejection must fail.

The rejection also appears to rely on the teachings of Hinds, albeit described relative to the rejection of claim 12 only, and urges that Hinds teaches the use of the recited 5 - 7wt% organic, non-hydrogenated palm stearin oil. Again, Applicants question what basis the Examiner relies upon for the alleged combination, other than the rejected claims themselves. Absent an indication for the motivation to combine the teachings of Liu and Hinds, it would appear that Applicants' claims have been used as the "recipe" from which teachings of various documents have been selected.

While Hinds describes testing of unhydrogenated palm oil, it does not teach or suggest the levels recited in the rejected claims. In fact, Hinds suggests that 2.0-2.5% palm oil is adequate to effectively stabilize peanut butter.⁴ Accordingly, Hinds fails to disclose or describe the use of the recited palm stearin oil, the hardest fraction of palm oil. Hinds also teaches away from the recited limitations of independent claims 1 and 12, as it specifically teaches that a lower percentage of a palm oil should be used. The Examiner suggests that the claimed percentages could be arrived at with little routine experimentation. This is not believed to be the standard of obviousness, and Hinds clearly arrived at and recommended a palm oil percentage that is significantly lower than the palm stearin oil recited in the claims. Hence the Examiner's assertion would appear to be contradicted by Hinds.

Lastly, Harris is apparently added to the arguable combination of Liu and Hinds. Harris

³ As to the response at p. 10 of the Office Action, that nothing has been shown to prove Liu would separate without a stabilizer, Applicants respond with a question of, "why Liu would have added a stabilizer (in the sweetening composition) if it wasn't needed?"

⁴ As the Examiner further notes, Hinds sets out the fatty acid composition of RBD palm oil at the bottom of col. 1 on p. 816, where the percentage of stearic fatty acid (C18:0) is 4-5.5%. Multiplied by 2.5 – 3% palm oil would appear to indicate that Hinds teaches only a fraction of a percent of stearic fatty acids.

is suggested to teach, relative to claim 12, that sugar and polyglycerols can be melted and used in the making of peanut butter. While Harris does teach the use of small portions of partial esters of polyglycerol (col. 3, lines 43-49), the "indicated" esters of the polyglycerols are "derived from normally solid higher molecular weight fatty acids or mixtures of fatty acids, such as palmitic acid, hydroxy-stearic acid, stearic acid, mixtures thereof, so called 'triple-pressed stearic acid' and the like. [m]ixtures comprising from about 40 to 50% of stearic acid and the remainder largely palmitic acid ... are very satisfactory sources of fatty acids" (col. 3, lines 28-42), and it is not clear that this teaching gives rise to the limitations set forth in independent claims 1 or 12. Nor has the Examiner even alleged that to be the situation. Rather, Harris is apparently used to conclude that one might be motivated to experiment and try unhydrogenated palm oil that contains stearic acid. Absent that suggestion, however, it appears that the rejection is largely based upon the Examiner's opinion rather than specific teachings.

As noted, the dependent claims are believed to be allowable for the reasons set forth for the independent claims, and Applicants have not provided further arguments in traversal of such rejections for the sake of brevity. As previously noted, however, the Examiner appears to have taken "official notice" with respect to several limitations (e.g., "[adding oil in mill] has to have been done in order for peanuts to have been ground..."; "reference is silent as to heating the oil") by asserting that the limitations recited in the claims are not new or would have to have been done, etc. Applicants urge that such conclusory statements also fail to meet the burden of *prima facie* obviousness.

In view of the incomplete rejection based upon, and arguable combination of, Liu, Hinds and Harris, and in the alternative, the lack of a teaching of specific limitations set forth in the claims, Applicants' respectfully request that the rejection be withdrawn relative to independent claims 1 and 12. Further arguments relative to the dependent claims are respectfully reserved for Applicants' Appeal Brief in the event the rejection is maintained.

Claims 1, 3-8, 10, 12-18, 20 and 22-23 were rejected under 35 USC §103(a) as being unpatentable over Hinds. In setting forth a rejection under 35 USC §103(a) of claims 1 and 12 based upon Hinds, the Examiner acknowledges that Hinds fails to teach all of the limitations set forth in the independent claims. Specifically, the Examiner acknowledges that Hinds fails to teach the limitation of about 5wt% to about 7wt% of a non-hydrogenated organic palm stearin oil. The Examiner then concludes that no patentable

distinction exists between the teachings of Hinds and the recited range of non-hydrogenated organic palm stearin oil. This is contrary to the statement by Hinds that "[p]eanut butter containing 3% palm oil would be unstable (Fig. 1c)" (p. 819; col. 2, 2nd para., last sentence), and "the maximum palm oil should be 2.5%, but the most stable products would contain 2.0-2.1% palm oil (Fig. 2b)" (p. 819; col. 2, 3rd para., lines 4-6).

Accordingly, not only does Hinds fail to disclose or describe the use of the recited palm stearin oil, the hardest fraction of palm oil, it also fails to disclose the specific amounts of oil set forth in the independent claims. Furthermore, the Examiner's assertions that "it would have been obvious to add a little more oil for its known function" appears to be inconsistent with the teachings set forth in Hinds at p. 819, as noted above.

Claims 9, 11, 19 and 24 were rejected under 35 USC §103(a) as being unpatentable over ____?____ and further in view of Krisinski (Krisinski et al.; 4,143,176). Applicants urge that the rejection is incomplete on its face as it fails to set forth the specific documents upon which the rejection is based (Liu, Hinds and Harris, or simply Hinds?). Notwithstanding the lack of specificity in the rejection, Applicants submit that the teachings of Krisinski, largely directed to processing of peanut skins, fails to set forth the specific limitations of claims 9 and 11. While Krisinski does teach the addition of skins, only a 50-60% portion of the germ is indicated as desirable. Applicants also continue to maintain that the limitations of claims 9 and 19 are not taught. In fact Krisinski indicates (col. 2, lines 25-41) that the additional step of homogenization was required to reduce undesirable characteristics, and that homogenization caused a loss of flavor volatiles. Thus, Krisinski would seem to teach away from the recited limitation of returning substantially all peanut germ separated from the peanuts during blanching as set forth in claims 9 and 19.

In view of the foregoing remarks and amendments, withdrawal of the remaining rejections is earnestly solicited from the panel.

Respectfully submitted,


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